

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Shuster, et al.

Serial No.: 10/571,086

Filed: March 6, 2006

For: EXPANDABLE TUBULAR

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Group Art Unit: Unknown

Examiner: Unknown

Attorney Docket Number 25791.307.04

MAIL STOP PCT

Bryan Lin
PCT Legal Examiner
PCT Legal Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being filed
with the United States Patent and Trademark Office via
EFS-Web on the following date.

Date August 27, 2007

Ellen Louclace
Ellen Louclace

Sir:

PETITION UNDER 37 C.F.R. § 1.182

Applicants refer to a telephone conference on February 22, 2007 between Attorney Advisor Richard Ross and Charles E. Van Horn who is also engaged to represent applicants in this matter as indicated by the attached Authorization to Act in a Representative Capacity (Attachment A). During that telephone conference, Mr. Van Horn explained that this is one of several applications in which essentially the same procedures were followed to reduce the number of claims presented for examination in the National Stage application. Although the procedures were found acceptable by the U.S. Patent and Trademark Office (PTO) in other applications, applicants want to

ensure that all applications are processed correctly and that any errors are corrected with minimal expense and inconvenience to both applicants and the PTO.

It was agreed with Mr. Ross, and subsequently with his successor, PCT Legal Examiner Bryan Lin, that applicants would seek an appropriate basis for relief in one of the affected applications, namely U.S. Patent Application No. 10/548,934, so that it could be used as a template for action in the other affected applications. Attached is a copy of the Decision on the Renewed Petition for Refund Under 37 CFR 1.26 that was treated as a Petition Under 37 CFR § 1.182 (Attachment B). As noted in the Decision, the Petition Under 37 CFR § 1.182 was granted and a refund of \$28,650.00 was deposited in Deposit Account No. 08-1394.

BACKGROUND

On September 7, 2004, applicants filed International Application No. PCT/US2004/028889 containing 1369 claims, which claimed the priority of United States Patent Applications No. 60/500,435 filed September 5, 2003, No. 60/585,370 filed July 7, 2004, and No. 60/600,679 filed August 11, 2004. The thirty month period for paying the basic national fee in the United States expired on March 5, 2006.

On March 6, 2006, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US) (March 5, 2006 was a Sunday; therefore the national stage papers were timely filed). The submission was accompanied by, *inter alia*, a substitute specification and a Preliminary Amendment attempting to reduce the number of claims from 1369 to 42, and authorization to charge \$11,000.00 for the basic national fee required by 35 U.S.C. 371(c)(1), the examination fee, the search fee, extra

claim fees for a total of 42 claims, and the fee for extra sheets, to applicants' representative's Deposit Account No. 08-1394.

On March 15, 2006, applicants' representative's Deposit Account No. 08-1394 was debited in the amount of \$11,000.00, including \$8,900.00 for extra claim fees for the reduced number of 42 claims instead of the original 1369 claims.

Applicants file the present Petition Under 37 CFR § 1.182 to waive the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees and consequently confirm that the fee calculation based on 42 claims is correct.

DISCUSSION

37 CFR § 1.26(a) states in relevant part,

The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

A review of international application PCT/US2004/028889 reveals that the application contained 1369 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP § 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. § 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR § 1.492(d)-(e) and/or eliminate the multiple dependent claim fee required under 37 CFR § 1.492(f). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle

applicant to a refund of fees previously paid. See MPEP § 607 and § 608.
(Emphasis added.)

In the present case, the initial national stage submission on March 6, 2006 did not include a proper preliminary amendment.

It is respectfully submitted, however, that it is apparent from the papers filed March 6, 2006 that applicants sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 42 claims, rather than the 1369 claims contained in the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 42 claims as opposed to 1369 claims. An improper Preliminary Amendment which did not include a listing of claims was filed together with the initial national stage submission on March 6, 2006. A second Preliminary Amendment was filed on December 5, 2006, which sought to reduce the total number of claims to 42, but was improperly formatted with renumbered claims. Therefore, applicants request that the Preliminary Amendments filed on March 6, 2006 and December 6, 2006 be withdrawn in favor of the Third Preliminary Amendment filed herewith which is consistent with the claims contained in the substitute specification and which reduces the total number of claims in this application to 42. It is also respectfully submitted that the Third Preliminary Amendment submitted herewith is responsive to and corrects the errors noted in the Notice of Non-Compliant Amendment (37 CFR § 1.121) mailed July 25, 2007. Because of applicants' intent to reduce the number of claims for examination, applicants submit that justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial

national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees.

REQUESTED RELIEF

Accordingly, applicants seek to confirm by submission of this Petition that the fee calculation based on 42 claims is correct.

A review of the fee records for the present application reveals that \$8,900.00 has been paid for excess claim fees. The application currently contains 42 total claims, including 42 independent claims. Thus, an extra claims fee of \$8,900.00 is required which is comprised of a fee of \$1,100.00 for 22 claims in excess of 20, and a fee of \$7,800.00 for 39 independent claims in excess of 3. Consequently, applicants hereby seek confirmation that the amount of \$8,900.00 already charged to applicants' representative's Deposit Account No. 08-1394 for extra claims fees was correct and that no additional extra claims fees are due.

CONCLUSION

The Commissioner is hereby authorized to charge payment of any fees associated with this Petition, including the fee due under 37 CFR § 1.17(f), or to credit any overpayment to Deposit Account No. 08-1394, Order No. 25791.307.04.

Prompt and favorable consideration of this petition and application are respectfully requested. If any additional information is needed or desired, please contact the undersigned at your convenience.

Respectfully submitted,

HAYNES AND BOONE, L.L.P.

Dated: August 27, 2007

By: 

Randall C. Brown

Reg. No. 31,213

Telephone: 214-651-5242

Fax: 214-200-0853

Attachments A and B

ATTACHMENT A

PTO/SB/64 (09-06)

Approved for use through 12/31/2008 OMB 0651-0035

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

AUTHORIZATION TO ACT IN A REPRESENTATIVE CAPACITY

In re Application of: Shuster, et al.

Application No. 10/571,086

Filed: March 6, 2006

Title: Expandable Tubular

Attorney Docket No. 25791.307.04

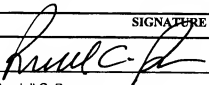
Art Unit: Unknown

The practitioner named below is authorized to conduct interviews and has the authority to bind the principal concerned. (Note: pursuant to 37 CFR 10.57(c), a practitioner cannot authorize other registered practitioners to conduct interviews without consent of the client after full disclosure.) Furthermore, the practitioner is authorized to file correspondence in the above-identified application pursuant to 37 CFR 1.34:

Name	Registration Number
Charles E. Van Horn	40,266

This is not a Power of Attorney to the above-named practitioner. Accordingly, the practitioner named above does not have authority to sign a request to change the correspondence address, a request for an express abandonment, a disclaimer, a power of attorney, or other document requiring the signature of the applicant, assignee of the entire interest or an attorney of record. If appropriate, a separate Power of Attorney to the above-named practitioner should be executed and filed in the United States Patent and Trademark Office.

SIGNATURE of Practitioner of Record

Signature		Date	2/6/07
Name	Randall C. Brown	Registration No., if applicable	31,213
Telephone	(214) 651-5242		

This collection of information is required by 1.31, 1.32 and 1.34. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



11 JUN 2007

ATTACHMENT B

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS, TX 75202-3789

In re Application of WATSON et al :
U.S. Application No.: 10/548,934 :
PCT Application No.: PCT/US2004/007711 :
Int. Filing Date: 11 March 2004 :
Priority Date Claimed: 11 March 2003 : DECISION
Attorney Docket No.: 25791.253.05 :
For: APPARATUS FOR RADIALY :
EXPANDING AND PLASTICALLY :
DEFORMING A TUBULAR MEMBER :

This is in response to applicant's "Renewed Petition for Refund Under 37 CFR 1.26" filed 27 November 2006 and "Supplemental Renewed Petition for Refund Under 37 C.F.R. § 1.26" filed 13 March 2007, which are being treated together as a petition under 37 CFR 1.182 as authorized by applicant. The requisite \$400.00 petition fee will be charged to Deposit Account No. 08-1394 as authorized in the petition.

BACKGROUND

On 11 March 2004, applicant filed international application PCT/US2004/007711, which claimed priority of an earlier United States application filed 11 March 2003. The thirty-month period for paying the basic national fee in the United States expired on 12 September 2005 (11 September 2005 was a Sunday).

On 12 September 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1), a substitute specification, and an authorization to charge any fees which may be required to a deposit account.

On 14 June 2006, applicant's deposit account was debited for excess claim fees.

On 30 June 2006, applicant filed a request for refund under 37 CFR 1.26.

On 26 September 2006, this Office mailed a decision dismissing the 30 June 2006 request for refund.

On 27 November 2006, applicant filed the present renewed request for refund under 37 CFR 1.26.

On 13 March 2007, applicant filed the present supplemental renewed request for refund under 37 CFR 1.26.

DISCUSSION

37 CFR 1.26(a) states in relevant part,

The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

A review of international application PCT/US2004/0007711 reveals that the application contained 520 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492*(d)-(e) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492*(f). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608, (Emphasis added.)

In the present case, the initial national stage submission on 12 September 2005 did not include a proper preliminary amendment. The petition states that the presentation of claims contained in the substitute specification should have been treated as an improperly formatted amendment, and that applicant should have been given an opportunity to file a corrected preliminary amendment in accordance with MPEP 714.01(e). Even assuming *arguendo* that applicant should be allowed to submit a corrected preliminary amendment, any corrected amendment would not have accompanied the initial national stage submission and thus would not be effective to reduce the number of claims to be considered in calculating extra claim fees in accordance with MPEP 1893.01(c). Therefore, the corrected amendment would not entitle applicant to a refund of the extra claim fees previously paid.

However, it is apparent from the papers filed 12 September 2006 that applicant sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 67 claims, rather than the 520 claims contained in

the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 67 claims as opposed to 520 claims. A proper preliminary amendment was filed on 13 March 2007, reducing the total number of claims to 67. Because of applicant's intent to reduce the number of claims for examination and because the fees paid towards the examination of claims are not remotely commensurate with number of claims that remain for examination, justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees. Accordingly, the claim fees paid based on the presence of the original 520 claims, less the claim fees based on the remaining 67 claims, are deemed to be in excess of that required, and refund of such excess under 37 CFR 1.26(a) is appropriate.

A review of the fee records for the present application reveals that \$33,600.00 has been paid for excess claim fees. The application currently contains 67 total claims, including 16 independent claims. Thus, a fee of \$2,350.00 for 47 claims in excess of 20 is required, and a fee of \$2,600.00 for 13 independent claims in excess of 3 is required. A total of \$28,650.00 will be refunded to Deposit Account No. 08-1394.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision and will be forwarded to Technology Center AU 3676 for examination in due course.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303

Facsimile: 571-273-0459

06/12/2007 SBASHEIR 00000001 081394 10548934

01 FC:1614 200.00 DA

Adjustment Date: 06/12/2007 SBASHEIR
06/14/2006 ILVANS 00000001 081394 10548934
02 FC:1614 6200.00 CR

Adjustment Date: 06/12/2007 SBASHEIR
06/14/2006 ILVANS 00000001 081394 10548934
01 FC:1615 22650.00 CR